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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/501,408	02/10/2000	Frederic Serre	A32979-070337.0181	3806
21839	7590	05/19/2004		
BURNS DOANE SWECKER & MATHIS L L P POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			EXAMINER SHOSHO, CALLIE E	
			ART UNIT 1714	PAPER NUMBER

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/501,408	SERRE, FREDERIC	
	Examiner	Art Unit	
	Callie E. Shosho	1714	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 23-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23-28 is/are allowed.
- 6) ☒ Claim(s) 29-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. All outstanding rejections are overcome by applicants' amendment filed 3/1/04.

In light of the new grounds of rejection as set forth below, the following rejection is non-final.

**Claim Rejections - 35 USC § 102**

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 29-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Lickes et al. (U.S. 6,533,008).

Lickes et al. disclose pneumatic tire obtained from rubber composition comprising 100 parts elastomer such as cis 1,4-polyisoprene or natural rubber or mixture of elastomers including cis 1,4-polyisoprene or natural rubber and styrene butadiene emulsion, styrene/isoprene/butadiene, or polybutadiene and 15-100 phr pyrogenic or precipitated silica wherein the silica possesses surface area of 50-300 m<sup>2</sup>/g. It is noted that Lickes et al. disclose the use of silica known under the tradename VN3 which is identical to that used in the present invention and thus would inherently possess SiOH surface functions as presently claimed. The rubber composition is used to produce apex, ply, chafer, or innerliner of the tire (col.1, line 66-

col.2, line 2, col.2, lines 33-34 and 42-57, col.3, lines 35-39 and 50-55, col.5, lines 25-39, and col.6, lines 20-29).

In light of the above, it is clear that Lickes et al. anticipate the present claims.

**Claim Rejections - 35 USC § 103**

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lickes et al. (U.S. 6,533,008) in view of Takeichi et al. (U.S. 6,008,295).

The disclosure with respect to Lickes et al. in paragraph 3 above is incorporated here by reference.

The difference between Lickes et al. and the present claimed invention is the requirement in the claims of specific type of additional diene elastomer.

Takeichi et al., which is drawn to rubber compositions for tires, discloses the use of silicon or tin halide modified diene elastomer in order to produce a composition with superior fracture properties and low hysteresis loss (col.1, lines 19-22, col.2, lines 34-55, and col.6, lines 45-55).

In light of the motivation for using specific type of additional diene elastomer disclosed by Takeichi et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use such diene elastomer in the tire of Lickes et al. in order to produce tire with superior fracture properties and low hysteresis loss, and thereby arrive at the claimed invention.

6. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lickes et al. (U.S. 6,533,008) in view of Fukahori et al. (U.S. 5,844,050).

The disclosure with respect to Lickes et al. in paragraph 3 above is incorporated here by reference.

The difference between Lickes et al. and the present claimed invention is the requirement in the claims of additional diene elastomer that has been modified by branching agent such as divinylbenzene.

Fukahori et al., which is drawn to rubber composition, disclose a diene elastomer comprising a majority of cis-1,4-bonds, which is branched using divinylbenzene (col.9, lines 4-14, 32 and 46-50) in order to produce a composition with good abrasion resistance, fatigue resistance, and tensile properties (col.25, lines 26-36).

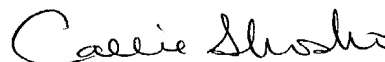
In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use such diene elastomer in the tire of Lickes et al. in order to produce tire with good abrasion resistance, fatigue resistance, and tensile properties, and thereby arrive at the claimed invention.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Callie E. Shosho  
Primary Examiner  
Art Unit 1714

CS  
5/14/04